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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,836	12/21/2001	Han-Soo Chung	DKC 1640	2816

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EXAMINER

BUTTNER, DAVID J

ART UNIT PAPER NUMBER

1712

DATE MAILED: 09/11/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,836

Applicant(s)

CHUNG ET AL.

Examiner

David Buttner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28 is/are allowed.
- 6) ☒ Claim(s) 1-22, 24-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 25 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "non-bromine polycarbonate" does not find basis in the original disclosure.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The "non bromine PC" limitation is unclear. Is merely a non bromine PC required to be present? Are all brominated PC's excluded?

Claims 1, 4-13, 16-20 and 24-27 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Rosenquist '036 Patent.

Rosenquist exemplifies (comp. A) a blend of polyestercarbonate, polycarbonate, polyetherimide-siloxane, KSS and 1.5 parts of titanium dioxide. This is "about 2 parts" of titanium dioxide (see MPEP 2173.05(b)). Even without "about", 1.5 so close to 2 that

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one would expect then to have the same properties (MPEP 2144.05; Titanium Metals v. Banner 227 USPQ 773).

Note that polyestercarbonate qualifies as polycarbonate according to applicant (page 4 line 20 of spec). Of 95 parts total PC, 55 parts are non brominated PC.

Claims 1-14, 16-22 and 24-27 rejected under 35 U.S.C. 103(a) as being unpatentable over the Ishii '550 Patent in view of Kirsch or J 2000302959.

Ishii exemplifies (# 3) a blend of PC, KSS, PTFE and grafted rubber. Ishii suggests (col. 7 line 57) the inclusion of pigments, but does not specifically name titanium dioxide.

Titanium dioxide is a well known pigment for polycarbonate compositions. It whitens and raises the reflectance (see paragraph 2 of J '959). It also raises the tracking resistance of polycarbonate compositions (see Kirsch col. 1 line 24).

It would have been obvious to add titanium dioxide to Ishii's composition for the expected advantages.

Claims 1-20 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over the J 2000302959 Patent in view of Mark '851.

J '959 suggests blends of PC, titanium dioxide, epoxy functional grafted rubber and flame retardants. The flame retardant can be a sulfonate salt (paragraph 22). No particular species are named.

Aromatic sulfonesulfonate salts are known flame retardants for polycarbonates (see claim 4 of Mark). It would have been obvious to choose any sulfonated salt flame retardant(s) for use in the J '959 composition.

Applicant's arguments filed 7/17/03 have been fully considered but they are not persuasive.

Applicant argues US 5837757 (incorporated by reference) provides basis for the "non-bromine PC" limitation.

The examiner is unable to find such a limitation in US 5837757. Note that mere absence of a positive limitation is not basis for an exclusion (MPEP 2173.05(i)). Also note applicant specifically allows for other halogenated PC (page 4 lines 6, 8 of spec).

Applicant argues 1.5 pph does not meet "about 2 pph" and would not have the same properties.

Applicant provides no evidence regarding 1.5 pph versus 2 pph. In re Ayers 69 USPQ 109 held that "at least about 10% was met by a reference not exceeding 8%. The record supports the examiner's position.

Applicant argues Rosenquist's comparative example A teaches away from the invention because it exhibits dripping.

The use of patents as references is not limited to what the patentee describes as his own invention (MPEP 2123). In other words, comparative examples can be relied on to formulate a rejection. Furthermore, if one is unconcerned with dripping, then this would not be a negative teaching. Apparently, applicant is not concerned with dripping.

Applicant argues Rosenquist shows adding titanium dioxide to a PC/KSS composition would adversely affect the Ishii composition.

Rosenquist does not show the effects of titanium dioxide. He compares two different sulfonates (STB versus KSS). The fact that STB is superior KSS is not relevant to whether or not it is obvious to select titanium dioxide as Ishii's pigment.

Secondly, Rosenquist's composition is significantly different from Ishii's composition. Rosenquist's composition is predominantly polyestercarbonate and brominated polycarbonate rather than bisphenol A polycarbonate. Rosenquist also includes polyimide-siloxane copolymer. Rosenquist cannot be relied on to prove anything regarding Ishii's composition. Also note Ishii includes an anti drip agent (PTFE) which would mitigate any dripping problems.

Rosenquist's composition is significantly different from the J '959 composition for much the same reasons.

Arguments that the secondary references (Mark or Kirsch) lack one of the claimed elements is never convincing. These references were not applied as anticipatory. The rejections utilizing these references were based on a combination of references. Attacking the references individually does not show nonobviousness (MPEP 2145 (IV)).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 703-308-2403. The examiner can normally be reached on Weekdays from 10:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

DAVID J. BUTTNER
PRIMARY EXAMINER

D. Buttner/mn
September 9, 2003

